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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/573,076	10/26/2006	Enrico Ferri	287681US0PCT	6982
22850 7590 09/19/2008 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER TORRES VELAZQUEZ, NORCA LIZ	
			ART UNIT 1794	PAPER NUMBER
			NOTIFICATION DATE 09/19/2008	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/573,076	Applicant(s) FERRI ET AL.	
	Examiner Norca L. Torres-Velazquez	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 and 25-27 is/are pending in the application.
- 4a) Of the above claim(s) 13-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 25-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 March 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>032306</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of claims 1-12 and 25-27 in the reply filed on July 17, 2008 is acknowledged. The traversal is on the ground(s) that the search of all of the claims would not impose a serious burden on the Office. This is not found persuasive because the elected claims lack the special feature of spinning of mineral fibers, such process step requires a search in class 264 which is not required for elected claims 1-12 and 25-27 .

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are indefinite as the claim scope is uncertain since a trademark is used in a claim as a limitation to identify or describe a particular material or product. It is further noted that the use of a trademark also constitutes an improper use of the trademark or trade name. [Refer to MPEP 2173.05 (u)]

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 1794

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-3, 7, 10-11 and 25-27 are rejected under 35 U.S.C. 102(b) as being anticipated by JASKOWSKI (US 4,847,140).

JASKOWSKI discloses a nonwoven composite insulation material that includes a layer of inorganic fibers bonded together by a carrier web of blended organic and inorganic fibers. (Col. 1, lines 6-10; col. 3, lines 58-68) The carrier web is needle punched to the layer of inorganic fibrous material to interlock the carrier web inorganic and organic fibers with the fibers of the inorganic fibrous material layer so as to bond together the fibers of the inorganic fibrous material and form a cohesive, nonwoven composite fibrous material. (Col. 3, lines 58-68 through Col. 4, lines 1-5) The reference teaches the use of mineral wool fibers, glass fiber, rock wool fiber, metal oxide fibers, graphite or carbon fibers in the primary layer or batt of inorganic fibrous material. (Refer to Col. 4, lines 15, 64; Col. 5, lines 36-39) The reference teaches that the layer of inorganic fibrous material has a pre-selected thickness and density applicable for a specific use as an insulation material. (Refer to Col. 5, lines 39-41) The reference further teaches the use of fiber such as polyester fibers and polyolefin fibers as the organic fibers of the carrier web. The inorganic fibers of the carrier web are selected from a group consisting of glass fibers, metal oxide fibers, carbon-graphite fibers and ceramic fibers. (Refer to Col. 6, lines 4-11) With regards to the diameter of the inorganic fibers, the reference teaches average diameters in the range of about 5 to 8 microns with individual fiber diameter ranging from 0.4 to 30 microns. (Col. 8, lines 48-54)

Art Unit: 1794

It is the Examiner's interpretation that the layer of inorganic fibrous material of the nonwoven composite fibrous material of the JASKOWSKI reference equates to the presently claimed core and that the carrier web layer equates to the claimed at least one facing layer.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over JASKOWSKI (US 4,847,140).

With regards to the thickness and basis weight of the layers, it is noted that the reference recognizes that the layers have a preselected thickness and density applicable for a specific use as an insulation material, a filtering medium, a fireproofing material and for other structural purposes. (Refer to Col. 5, lines 35-43; Col. 3, line 66; col. 4, line 13) In the Examples, the reference teaches that the composite fibrous material has a thickness of about 2 inches and a weight of 1.67 lbs. per sq.ft. The mineral wool layer has a weight of 1.587 lbs. per sq. ft. [7.748 kg/sq. m] and the top and bottom carrier web layers have a combined weight of 0.083 lbs. per sq. ft. [0.405 kg/sq.m]. (Refer to Example 1)

“[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.” In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955) Further, it is noted that it is well settled

Art Unit: 1794

that determination of optimum values of cause effective variables such as thickness and weight is within the skill of one practicing the art. In re Boesch, 205 USPQ 215 (CCPA 1980).

Claim Rejections - 35 USC § 103

8. Claims 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over JASKOWSKI (US 4,847,140) as applied to claim 1 above, and further in view of GRIFFITH et al. (US 5,486,232).

JASKOWSKI is silent to the use of chemical binders.

GRIFFITH et al. teaches tacking agents for glass fiber articles of manufacture useful as insulation. It discloses a process for preparing a tacking agent which will bind glass fibers comprising an aluminum phosphate mixed ionic condensed polymer. (Col. 1, lines 4-11)

Since both references are related to insulation materials, the purpose of GRIFFITH et al. would have been recognized in the art of JASKOWSKI.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the material of JASKOWSKI and provide with a chemical binder containing aluminum phosphate with the motivation of producing a material that will have regain of shape after deformation of the glass fibers as by compression as disclosed by GRIFFITH et al. (Refer to Abstract).

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over JASKOWSKI (US 4,847,140) as applied above, and further in view of TETART et al. (US 5,025,077).

TETART et al. relates to glue compositions for mineral fibers in the manufacture of insulation products. (Abstract) The reference teaches the use of additives that act as anti-dust agents by preventing the mineral fibers from flying off in the form of dust. (Refer to Col. 3, lines

Art Unit: 1794

62-66) Thus, it would have been obvious to one having ordinary skill in the art of glass insulation products to use anti-dust agents/additives to achieve the predictable result of preventing mineral fibers from flying off in the form of dust as taught by TETART et al. A reference may be understood by the artisan as suggesting a solution to a problem that the reference does not discuss. See KSR, 137 S. Ct. at 1742, 82 USPQ2d at 1397 “Common sense teaches... that familiar items may have obvious uses beyond their primary purposes, and in any cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle. ... A person of ordinary skill is also a person of ordinary creativity, not an automaton.”).

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

HIERS (US 4,522,876)

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Norca L. Torres-Velazquez whose telephone number is 571-272-1484. The examiner can normally be reached on Monday-Thursday 8:00-5:00 pm and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1794

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Norca L. Torres-Velazquez/
Primary Examiner, Art Unit 1794

September 14, 2008